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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,695	03/03/2004	Valerie Jeanne-Rose	05725.0926-01	4329

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EXAMINER	
VENKAT, JYOTHSNA A	
ART UNIT	**PAPER NUMBER**
1615	

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/790,695	JEANNE-ROSE ET AL.	
	Examiner	Art Unit	
	JYOTHSNA A VENKAT Ph. D	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 50-68 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 50-68 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of amendment and response filed on 11/10/04. Claims 50- 68 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 50-68 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 6,352,699 ('699).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See col.3, line 25 for formula IA which is the same compound claimed, see the definition of R1 at col.3, line 41, see col.4, lines 55-58 for the species, see col.2, for recitaion of " sol", see example 1 for the concentration of the organometallic compound which is within the claimed ranges, see also col.6, lines 30-47 for the ranges, see col.7, lines 45-49 which reads on the claimed method of " protecting the hair " since the patent discloses that even after several washes using water and shampoo, the initial waviness of the hair is retained" and the disclosure at col.8, lines 1-9 reads on the claimed method of strengthening a keratin material . The compound is same and application of the compound to the keratin (nail) is same, there fore the method claimed in claims 53-59 and the method claimed in claim 69 in the body of the claim " effective to reduce the brittleness of the human nails " is inherent.

The use of the term " comprising" permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts. **Moleculon Research corp., v. CBS, Inc.,** 793 F. 2d 1261, 229 USPQ 805 (FED. Cir. 1986); In **re Baxter**, 656 F. 2d 679, 210 USPQ 795, 803 (CCPA 1981).

Response to Arguments

3. Applicant's arguments filed 11/10/04 have been fully considered but they are not persuasive.

4. Applicants argue that claims 50-68 are directed towards a method of protecting and/or strengthening a keratin material . . . wherein said composition is applied to said keratin material in an amount effective to obtain at least one of harder nails, stronger nails, less brittle nails, nails

which no longer split and nails which no longer crack (emphasis added and claim 68 is directed towards "a process for treating keratin material . . . wherein said composition is applied to said keratin material in an amount effective to reduce the brittleness of human nails" and argue that even though the patent discloses nail varnish, for example in examples 1 and 2 at column 8, line 30 to column 9, line 14, the patent does not teach or suggest the method of applicants' claims, i.e., obtaining at least one of harder nails, stronger nails, less brittle nails, nails which no longer split, and nails which no longer crack and reducing the brittleness of human nails. Applicants also argue that the patent is silent with respect to any effect the composition might have on the substance of the keratin material (i.e., the nail) itself, instead, teaches the nail varnish composition and the film it forms and says nothing about properties transferred to the actual nail material.

5. In response to the above argument, it is the position of the examiner that the patent anticipates the claimed method. Admitted by applicants that the patent discloses nail varnish composition , the patent at col.8, lines 607 discloses that the film deposited on the nails has excellent gloss and **good surface hardness(emphasis added).** The composition has **the same metallic precursor** and the same composition is applied to **the same population**. Good surface hardness on the nails implies that harder nails or stronger nails or less brittle nails or nails which longer split and nails which no longer crack are obtained. The patent does not explicitly recite all these properties, but all these properties are connected, because of the patent teaching good **surface hardness on the nails**. Less brittle nails means the nails will not crack or no longer split. When nails have hard surface it cannot split or crack. The instant specification does not define the meaning for " harder" " less brittle " , stronger". Note all these terms are relative. When the

nails have good surface hardness, this gives the property of strengthening the nails. Therefore, it is the position of the examiner that the **patent anticipates the "claimed method ---** wherein said composition is applied to said keratin material in an amount effective to obtain at least one of harder nails, stronger nails, less brittle nails, nails which no longer split and nails which no longer crack.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615

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